

REMARKS/ARGUMENTS

In the April 12, 2005 Office Action, the Examiner issued a Restriction Requirement that requires the Applicant to elect a single disclosed species. The Examiner has identified four species: Species 1: Fig. 1A; Species 2: Fig. 1B; Species 3: Fig. 1C; and Species 4: Fig. 4. Office Action at page 2). Additionally, the Examiner identified two Subspecies: coil stent and mesh stent. Applicant provisionally elects Species 1 and Subspecies coil stent **with traverse**. Claims 1, 10, 13-26, 29-51, 60-73, 76-82, 91-105, 108-115, 124-137 and 140-145 are generic.

A Restriction Requirement is proper when two criteria are satisfied: 1) the claimed inventions are independent or distinct as claimed; and 2) a search of the claimed subject matter would impose a serious burden on the Examiner. (MPEP § 803). Applicants respectfully submit that the Examiner did not provide a *prima facie* showing that a search and/or examination of the claimed subject matter would impose a serious burden. The Examiner has not demonstrated any of the several indicia of a serious search and examination burden. Specifically, the Examiner has not demonstrated that the allegedly different inventions would: 1) be classified separately; 2) have achieved a separate status in the art; or 3) require a different field of search as defined in MPEP § 802.02. (MPEP § 803).

The Examiner has provided no evidence or reasoning that would support a *prima facie* showing that a search and/or examination of the claimed invention would impose a serious burden. In the Advisory Action dated March 15, 2005, which has been withdrawn, the Examiner indicates removing the limitation “for facilitating retrograde supply of oxygenated blood to heart tissue through a coronary sinus” from claim 1, raises new issues that would require further consideration/search. However, the amendment to claim 1, which was filed on August 3, 2004, was searched and examined for the Office Action dated December 1, 2004. The amended claims, Claims 1, 10, 13 and 49, or claims added by amendment, Claim 50 on August 3, 2005 and Claims 51-145 on February 28, 2005, neither add additional inventions as new claims nor transform the claims into inventions different than those that remained after the Examiner’s initial Restriction Requirement dated May 3, 2004. Moreover, claim 1 was amended to include the limitation in dependent claim 11, which the Examiner indicated would be allowable if written in independent format. Furthermore, claim 51 was added to include the limitation in dependent

claim 12, which the Examiner indicated would be allowable if written in independent format. The dependent claims 52-145 all depend directly or indirectly from one of the independent claims 1, 49 or 51. The Examiner indicated claim 49 was allowable in the Office Action date December 1, 2005. As previously stated, the Examiner indicated claims 1 and 51 would be allowable if the amendments were made.

The Restriction Requirement is improper for several reasons. First, the claims filed on February 28, 2005 were amended to incorporate language the Examiner indicated would be allowable if written in independent format. Second, the claims are classified in a single class/subclass and have undergone multiple searches and examinations. Notably, claims 1-34 and 49-50 have been searched and examined by Examiner Ho on at least two occasions—May 3, 2004 and December 1, 2004. Accordingly, the Examiner has merely concluded that a species election is necessary and has neither shown: 1) how the claim amendments transform the claims—claims that have been pending for over three years and that have been searched and examined by this Examiner on at least two occasions—into “newly claimed inventions”; or 2) how the amended claims impose a serious burden on the Examiner.

Even if the Examiner established a *prima facie* showing that the claimed subject matter is drawn to independent or distinct inventions, the Examiner should withdraw the Requirement, because the required “serious burden” for either a search or examination of the pending claims has not been established. The claims subject to the Examiner’s Requirement have already been extensively searched and examined, so any allegation of “serious burden” cannot stand. Consequently, since this necessary element of a Restriction Requirement has not been established, the MPEP states that “the Examiner must examine [the claimed invention] on its merits, even though it includes claims to independent or distinct inventions.” MPEP § 803. Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding Restriction Requirement .

CONCLUSION

This application is in condition for allowance, and early notice to that effect is earnestly solicited. Should the Examiner have any questions, comments or suggestions in furtherance of

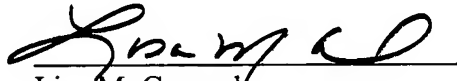
the prosecution of this application, she is invited to contact applicant's representative by telephone at the number indicated below.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250, reference No. 02012.4121. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MILBANK, TWEED, HADLEY & MCCLOY LLP

Dated: April 12, 2005



Lisa M. Coward
Registration No. 44,091

Customer No. 000038647
Milbank, Tweed, Hadley & McCloy LLP
International Square Building
1825 Eye Street, N.W., Suite 1100
Washington, D.C. 20006
Telephone: (202) 835-7504